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In the Supreme Court of the United States

OCTOBER TERM, A. D. 1952.

No. .....

AERATION PROCESSES, INC.,
a corporation,
Petitioner,

vs.

LOUIS A. LANGE and JOSEPH B. WINKLER, etc., *et al.*,
Respondents.

PETITION FOR A WRIT OF CERTIORARI.

To the Honorable The Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Aeration Processes, Inc., respectfully prays that, because of **CONFLICT BETWEEN COURTS** of Appeals, between each Court of Appeals and its District Court and, also, with the decisions of this Court, a writ of certiorari issue to the United States Eighth Court of Appeals:

1. To review the decree of that Court, contrary to the decisions of this Court,[1] holding the claims in issue of Getz United States Patents Nos. 2,294,172[2] and 2,435,682,[2] both continuations-in-part of application, Serial No. 710,236, filed February 8, 1934, not infringed because of a claimed dedication of the subject matter of that application by reason of its abandon-

[1] See p. 5, this petition.

[2] For convenience referred to hereinafter as "172" (the process patent) and "682" (the product patent). Emphasis ours unless otherwise stated.

ment in favor of continuation-in-part applications maturing into the above patents.

2. To review the conflict between the Second and Eighth Courts of Appeal and the Court of Customs and Patent Appeals on the legal status of the basic original Getz application, Serial No. 710,236, filed February 8, 1934, used by the Second Circuit Court of Appeals to hold the Getz Patent 172 invalid; and

3. To review the conflict between Circuits on the question of validity and settle the validity of the patents in suit for the public benefit in view of pending litigation in the Seventh Circuit and potential litigation elsewhere.

SUMMARY STATEMENT OF THE MATTER INVOLVED.

Nature of the Subject Matter: Unexpected Discovery in Physical Chemistry: A New Industry Results.

The patents in suit made a new industry of national scope.[3] They represent the inventor's discovery of a new process and its product through the discovery of unexpected properties of N_2O, "laughing gas," of the dental chair and the hospital surgery, to produce a whipped cream

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[3] The Eighth Circuit Court of Appeals said:

"* * * In the case before us the evidence shows that Getz, after study, experimenting and observing, obtained unexpected and unforeseeable advantages by a process which he discovered of aerating cream with nitrous oxide under pressure and suddenly releasing the pressure and discharging the product and this novel product, the like of which had never been known before, promptly began and now continues to appeal to and please millions of people. The new process made it practicable to produce the confection in quantities and to extend the distribution of it commensurately with the demand. **A substantial new industry of national scope has resulted.** * * *" (Opinion by Judge Woodrough, C. A. 8, May 20, 1952, pp. 5, 6.)

food product by impregnating the cream with a gas for sanitary dispensing in drug stores, homes, etc.

Before the advent of this discovery, cream was whipped mechanically in one batch, making sanitary disposal impossible. Whipped cream was the most difficult problem of the dairy industry. (Vol. I, page 85.)[4]

Getz discovered by impregnating that complex substance of vitamins, minerals, serum, acids, etc., known as cow's cream with nitrous oxide in a container provided with a release valve that, by releasing the pressure of 25 to 200 pounds to the square inch, he got an overrun of 500 to 700% (hand whip 100%) (Vol. I, R. 88); the large butterfat particles were disrupted into small, uniform, evenly distributed particles to give stability and plasticity to the foam that would be stable up to two hours; the butterfat content could be reduced from 30-35% to 20% to reduce cost (R. 88); that there was low drainage and the remarkable discovery that the **overrun with a given gas pressure is substantially independent of the fat content of the cream contrary to all predictions** (R. 88, 92); and that the gas was equally soluble in water, butterfat and serum of the cream.

Getz pushed back the frontiers of chemistry and physics by his discovery in this physical chemistry problem that the overrun at a given pressure will be independent of the fat content of the cream (R. 92); that the overrun is directly proportional to the pressure (R. 92); and that with a low fat content he got an overrun of 700%, contrary to the rule that with low fat content there was lesser expansion and no drainage. (R. 92.)

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[4] Dr. Hugo H. Sommer, Professor of Dairy Technology, University of Wisconsin, a witness of national distinction, said "In fact, whipping cream is probably the most troublesome single product of milk distributors."

It would normally be expected from the law of gases that, if you increase the pressure to produce a large expansion, any foam would be weakened, **but in this case it was strengthened unexpectedly.** (P. X. I, Vol. II, p. 188.) The discovery that the lower the mix in butterfat, the more stable the whip when dispensed at higher pressure so as to yield a greater overrun, was an actual discovery of first rate importance. This result was unpredictable from all known data.[5]

The second basic discovery was, **in the case of cream containing animal fat,** contrary to water and milk, the nitrous oxide changed the volume, chemical composition and physical characteristics of the cream when butterfat was present in substantial amounts with its serum.

The defendant in the Eighth Circuit uses 85% nitrous oxide and 15% carbon dioxide which the District Court found had no effect on the operation of the nitrous oxide.

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[5] R. 150, 151. The Court of Appeals of the Eighth Circuit said: "* * * Nobody will ever be tempted to go back again to a crude beating of air into rich cream to make whipped cream for commercial use. The discovery of the efficacy of the chemical N_2O to accomplish the result by the Getz method renders any such a proceeding obsolete. Up to the time of trial there appeared to be no chemical that would alone achieve the object except the N_2O that was first inventively chosen, tried out and found to be effective by Getz. * * * **But nothing in the record indicates to us that the use of carbon dioxide to produce whipped cream was an old art or that Getz so considered it or that he merely chose nitrous oxide as a substitute for it. Before his invention neither of the gases had been used to accomplish the object he was seeking. He chose the nitrous oxide by the kind of intuition which is inventive genius in the field of chemistry where there is no prevision and only actual test is demonstrative.** *Corona Cord Tire Co. v. Dovan Chemical Co.*, 276 U. S. 358; *Naylor v. Alsop Process Co.*, 168 F. 911. This is a chemical case, notwithstanding that practical inertness of the chemical instead of radical change in it was desired and attained in the process, and Getz was the original inventor of the process for making commercial whipped cream by the use of the particular chemical."

(Vol. I, Finding 5, p. 72.)[6] The defendant in the Second Circuit used all nitrous oxide and was found an infringer by both Courts.

POINTS OF CONFLICT.

We base this petition upon **questions of public importance:**

I. Conflict between the Eighth and Second Courts of Appeal and conflict within each Circuit between each Court of Appeal and its District Court on the validity of the patents in issue.[7] In view of pending litigation in the Seventh Circuit and in the Second Circuit and additional potential litigation, settlement of these questions is of **practical public importance.**[8]

II. Conflict of great public importance of the decisions of the Second and Eighth Courts of Appeal with the decisions of this Court in *Godfrey v. Eames,* 1 Wall. 317; *Smith v. Goodyear Dental Vulcanite Company et al.,* 93 U. S.

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[6] "A cream mix when charged with such a mixture at pressures of 80 and 100 pounds per square inch is from 5.8 and 6.1 times as acid as is cream charged with nitrous oxide at those pressures, **but from the practical standpoint of taste it is not discernible as acid."**

[7] *Aeration Processes, Inc. v. Walter Kidde and Co.,* 77 F. Supp. 647 (D. C. W. D. N. Y.) holding patent 2,294,172 on process valid and infringed (defendant used 100% nitrous oxide): *Aeration Processes, Inc. v. Walter Kidde and Co.,* 170 F. (2d) 437 (2 C. A.) holding patent 2,294,172 invalid, but no reversal on infringement: *Aeration Processes, Inc. v. Lange and Winkler* (D. C. E. D. Missouri), unreported, see R. 70 etc., for findings and conclusions on Patents 2,294,172 and 2,435,682 (Product) invalid, but infringed (defendants used 85% nitrous oxide and 15% carbon dioxide): *Aeration Processes, Inc. v. Lange and Winkler,* ____ F. (2d) ____ (8 C. A.), 93 U. S. P. Q. 332, both patents valid, but not infringed.

[8] *Aeration Processes v. Aerated Container, et al.* (D. C. N. D., Ill. E. Div. C. A. No. 47-C-962); *Aeration v. Andes* (D. C. N. D., Ill. E. Div. C. A. No. 47-C-951); *Aeration v. Walgreen* (D. C. N. D., Ill. E. Div. C. A. No. 48-C-178); *Aeration v. Deco* (D. C. W. D. N. Y. C. A. No. 3697).

486, 500, 501; *Chapman et al. v. Wintroath*, 252 U. S. 126, 137, etc., which hold that continuation applications on which the patents in suit are based, one of which was filed while the parent application was still pending, **constitute with the parent application one continuous application:** and the abandoned application in favor of the continuation applications cannot be used to let an infringer escape (8 C. A.)[9] or to anticipate or show abandonment of the invention (2 C. A.).[10] *Kinsman v. Parkhurst*, 18 How. 243, 247 (1855). *Temco Electric Motor Company v. Apco Manufacturing Company*, 275 U. S. 319.

III. Conflict of the decisions of the Eighth and Second Circuit Courts of Appeal holding that original abandoned applications could be used either to show non-infringement (8 C. A.) or anticipation (2 C. A.) with decision in *Reinecke v. Getz*, 126 F. (2d) 498, 499 (C. C. P. A.), the *later decision being in accord with the decisions of this Court (supra) that the original application and the continuation application are one application for all purposes.*[11]

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[9] *Aeration Processes, Inc. v. Lange and Winkler*, ____ F. (2d) ____, (8 C. A.), 93 U. S. P. Q. 332.

[10] *Aeration Processes, Inc. v. Walter Kidde & Co., Inc., et al.*, 170 F. (2d) 437, 438 (2 C. A.)

[11] This was an interference case of Dr. Getz involving the process patent 2,294,172, filed September 26, 1935, application Serial No. 42,225, a continuation of his earlier and abandoned application Serial No. 710,236 (Vol. III, D. X. 11), filed February 8, 1934. This abandoned application was used by 2 C. A. to form basis for anticipation (but not on infringement) and by 8th C. A. to form basis for holding non-infringement (but not on validity). The Court of Customs and Patent Appeals treated the abandoned application, Serial No. 710,236, *as one* continuous application with the process patent 2,294,172, saying

"(1) The interference arises between two applications for patent, that of appellant Serial No. 73,486, filed April 9, 1936, a division of an earlier application Serial No. 36,338, filed August 15, 1935, and appellee's application Serial No. 42,225, filed Sep-

(Continued on following page)

IV. Conflict of decision of 8th C. A. with *Temco Electric Motor Company v. Apco Manufacturing Company*, 275 U. S. 319; *Smith v. Snow et al.*, 294 U. S. 1, 20, holding that neither a later improvement nor lack of improvement by the use of additional matter to the patent in suit can avoid infringement. The Eighth Circuit Court of Appeals held that the claims of both patents in suit were avoided by defendants' use of nitrous oxide (N_2O) by using 85% of nitrous oxide and 15% carbon dioxide (CO_2). The District Court (D. C. E. D. Missouri) found (R. Vol. I, p. 72) that N_2O gas was undisturbed, that use of 15% carbon dioxide which had no deleterious effect because "from the practical standpoint of taste it is not discernible as acid." [12] The Getz patents in suit and the original application, Serial No. 710,236, state that these gases can be

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[12] *Finding 5.* "* * * Defendants Lange and Winkler have since beginning September 1, 1947, purchased the gas mixture from The S. S. White Dental Mfg. Co., which is the owner of Patent No. 2,155,260 describing and claiming the employment of such a mixture for the charging and dispensing of cream. A cream mix when charged with such a mixture at pressures of 80 and 100 pounds per square inch is from 5.8 and 6.1 times as acid as is cream charged with nitrous oxide at those pressures, **but from the practical standpoint of taste it is not discernible as acid.** The process followed by Lange & Winkler herein is the process described by Getz in his Patent No. 2,294,172 and claimed in Claims 1, 2, 3, 4 and 6 thereof and contributorily in Claim 5 thereof; that the process followed by the other defendants herein is the process described by Getz in his Patent No. 2,229,172 and claimed in Claim 5 thereof and contributorily in Claims 1, 2, 3, 4 and 6 thereof; and the product thereof is described by Getz in his Patent No. 2,435,682 and claimed in Claims 1, 2, 3, 4 and 5 thereof." (Emphasis ours.) (R. Vol. I, P. 72.)

(Continued from preceding page)

tember 26, 1935, a continuation of his earlier and abandoned application Serial No. 710,236, filed February 8, 1934. Appellant is therefore the junior party and had the burden to establish priority of invention by a preponderance of evidence."

used together, but that CO_2 should be used sparingly and that N_2O gives the result[13] while CO_2 is cheaper.

COURT DECISIONS.

District Court, Western District, New York:

The Court held the method patent 172 valid and infringed by use of nitrous oxide in cream.

Second Circuit Court of Appeals:

The Court held method patent 172 invalid for two reasons: (1) under the *de gustibus doctrine* **originated by the Court,** the invention consisted of a mere selection of a sweet gas (N_2O)[14] in place of a sour gas (CO_2), ignoring the fact that **Getz was the first to suggest and use a gas for producing a whipped cream without freezing it to make it stiff;** and (2) that Getz had filed application, Serial No. 710,236, filed February 8, 1934, claiming (a) any gas to whip cream; (b) nitrous oxide to whip cream; and (c) a combination of nitrous oxide and carbon dioxide to whip cream; and had filed continuation-in-part applications re-

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[13] Getz No. 172 said: "Carbon dioxide, which reacts with water to form free carbonic acid, was open to the objection it gives a sharp and, to many people, an unpleasant taste to cream. * * *" (p. 2, right-hand column, lines 13-16.)

Getz No. 682 said: "* * * **The advantages of such mixtures are, however, somewhat theoretical from a production standpoint, since nitrous oxide alone is satisfactory.**

"The nitrous oxide need not be used in a pure form but may contain other gases so long as they do not interfere with the essential action of the nitrous oxide. For example, a minor amount of carbon dioxide mixed with nitrous oxide can be tolerated so long as the amount is not sufficient to cause an objectionable acid or biting taste to the product. Its use, however, is not recommended in an edible aerated cream." (p. 2, column 4, lines 42-52.)

The 8th C. A. found: "Before his (Getz) invention neither of the gases had been used to accomplish the objective he was seeking."

[14] We use the chemical symbols N_2O for nitrous oxide and CO_2 for carbon dioxide.

sulting in method patent 172 and product patent 682 based upon the abandoned first application.

The Court treated the abandoned application as a disclosure of the prior art and a dedication of the subject matter to the public (and therefore a mere matter of taste) instead of following this Court's decisions that such first application and its successors are one continuous application.[15]

The Court ignored the statements in the patents in suit that (a) nitrous oxide is the gas that does the work and (b) that a small proportion of the cheaper CO_2 is permissible so long as it does not affect the operation of N_2O.

The Court ignored the fact that it was not a question of the negative taste of CO_2, **but of the positive properties unexpectedly found in N_2O in cream.** Besides, Getz was the first to discover that CO_2 had some of the properties he was looking for. (8th C. A. Opinion.)

The presence of CO_2 in N_2O, or its absence, would have no effect on the discovery of the art of whipping cream by gases without freezing to get a "nice, stiff whip," which Getz was the first to discover and the first to claim.

The Court erred in treating CO_2 as if it were in the prior art of whipping of cream, relying upon the abandoned application as part of the proof, whereas that was untrue and the Eighth Circuit Court of Appeals has so found.

District Court, Eastern District, Missouri:

The Court found the patents were infringed, if valid, by the use of 85% N_2O and 15% CO_2. Finding 5, Vol. I, page 72, saying the small addition of CO_2 *"from the practical standpoint of taste, it is not discernible as an acid."* It held the patents invalid in view of the prior art.

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[15] *Godfrey v. Eames*, 1 Wall. 317; *Smith v. Goodyear Dental Vulcanite Company, et al.*, 93 U. S. 486, 500, 501; *Chapman, et al. v. Wintroath*, 252 U. S. 126, 137, etc.

No opinion was written.

The product patent 682 was in litigation for the first time in the Eighth Circuit.

Eighth Circuit Court of Appeals:

The Court held that both patents were valid. It held that the defendants' use of 85% nitrous oxide and 15% carbon dioxide did not infringe the patents in suit because of the presence of 15% carbon dioxide, **despite the finding of fact by the Court below that such a small amount of carbon dioxide had no effect.** (Finding 5, Vol. I, R. 72.)[16] The Eighth Circuit Court of Appeals based its decision on non-infringement upon the Defendant's contention recited in the opinion that (1) Getz abandoned his claim to a mixture of carbon dioxide and nitrous oxide in his original application and confined it by that abandonment to nitrous oxide only; (2) that he knowingly and unequivocably abandoned all claim to any carbon dioxide;[17] (3) that the mixture was patented at a later date than the patents in suit by The S. S. White Dental Mfg. Co., Patent No. 2,155,260, that company supplying the mixture of gases to the Defendant;[18] (4) that the mixture of gases covered by the latter patent was, therefore, different and

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[16] The Getz patents cover any contamination by carbon dioxide when the amount is so small as found by the Court below as not to interfere with the operation of nitrous oxide: Getz in his patents warns that carbon dioxide is not satisfactory but that a little mixed with the nitrous oxide would have no effect and was not acid. This reservation in his patents protects him against infringers who try to cheapen the mixture, or avoid infringement.

[17] Error of law that a continuation-in-part application can be anticipated by the abandoned application upon which based.

[18] Operating under a later patent owned by third parties cannot avoid infringement where the essence of the earlier patent, such as use of the predominating nitrous oxide, is still used. *Kinsman v. Parkhurst*, 18 How. 243, 247 (1855); *Temco Electric Motor Company v. Apco Manufacturing Company*, 275 U. S. 319.

a new combination;[19] and (5) that 15% carbon dioxide makes the mixture with 85% many times as acid as carbon dioxide alone, despite the finding of fact by the District Court to the contrary in Finding 5 (see Footnote 12, p. 7); and despite the reservation to this effect in the patents themselves. (Footnote 13, p. 8.)

REASONS FOR ALLOWANCE OF THE WRIT.

I.

Conflict: The Circuit Courts differ on validity: The Second Court of Appeals differed with its District Court on validity: the Eighth Circuit Court of Appeals differed with its District Court on validity and infringement, but agreed with the District Court of New York on validity: both Circuit Courts differ with the Court of Customs and Patent Appeals on the effect of a continuation-in-part application and its use in connection with a continuation-in-part application and its patent; and both Courts of Appeal differ on this subject with the decisions of this Court.

The conflict between all Courts is of public importance and we respectfully urge that it be settled. *Forsyth v. Hammond*, 166 U. S. 506, 514. The existence of litigation pending in other Circuits awaiting trial necessitates that the scope and validity of the patents in suit be settled.

This is of great practical importance in view of the fact that Getz established under these patents a new industry of national scope as found by the Eighth Circuit Court of Appeals; and this new business should be protected and its status established.

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[19] There is no claim in the later patent that it was different from the Getz patents, but only an improvement and the Court has found below that 15% carbon dioxide was too small to have any material effect.

Further conflict arises between Courts due to the fact that the invention was based upon an abandoned patent application in the Patent Office. This was held by the Patent Office in all of its tribunals and the Court of Customs and Patent Appeals as a part of a continuous application represented by the continuation-in-part applications now in suit in harmony with the decisions of this Court. The Court of Customs and Patent Appeals, as did the Patent Office, gave effect to this abandoned patent application as a part of the continuation-in-part applications and awarded priority to Getz. Thus, this whole question was considered in the Patent Office and the Court of Customs and Patent Appeals and was "subjected to close and careful scrutiny under the stimulus of a heated contest" which greatly increases the weight of presumption of novelty and patentability. *Hildreth v. Mastoras*, 257 U. S. 27, 32.

II.

A patent application upon which a continuation-in-part application is founded and filed before the parent application was abandoned cannot be used for anticipation or to show dedication of its contents to benefit later infringers. The abandoned application and the continuation-in-part applications are treated as one continuous application.

The Second Circuit used this same abandoned application as if it were part of the prior art and constituted a publication of the use of carbon dioxide for whipping cream although the abandoned application also covered nitrous oxide, carbon dioxide and nitrous oxide in the mixture and any gas of this type for whipping cream. The Second Circuit position was that it could use this abandoned patent application (which was a secret document in

the Patent Office and never published) as a prior publication and, therefore, the later patents in suit, concentrating primarily on nitrous oxide, were invalid because it was merely an alternative selection of gases, ignoring the fact that Getz was the discoverer of these gases to whip cream.

There is no abandonment in an abandoned application as it is *a continuous application* with the continuation-in-part patents. An abandoned application unpublished is not a publication. The abandoned application cannot be used as prior art to anticipate or limit the scope of the patents based upon it under the decisions of this Court and the continuation-in-part patents specifically reserved the inclusion of a small amount of carbon dioxide to cheapen the gas provided that not too much was used to affect the nitrous oxide.[20]

The Eighth Circuit Court of Appeals has rendered a decision contrary to the above by holding that the abandoned application was a dedication of any mixture containing nitrous oxide and carbon dioxide and, therefore, could not be claimed by the patents in suit although those patents in suit are directed to the major portion of the gases being nitrous oxide such as used by the defendant and specifically reserved the right that a small proportion of carbon dioxide had been used without avoiding infringement.[21]

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[20] See footnote 13, page 8, this Petition.

[21] The ruling in this case of the Court of Appeals of the Eighth Circuit is contrary to its own decisions, such as, *Diamond Power Specialty Corp. v. Bayer Co.*, 13 F. (2d) 337, holding that delay in filing new claims did not create an estoppel and where the subject matter of the new claims was disclosed in the original specification and drawings even a new oath was not required. It further held that the publication of an article does not (in this case a very full article was published after the first application by Getz explaining later unexpected properties) constitute a dedication or a publication of anticipatory character with refer-

(Continued on following page)

The Eighth Circuit Court's position is contrary to *Godfrey v. Eames,* 1 Wall. 317; *Smith v. Goodyear Dental Vulcanite Company et al.,* 93 U. S. 486, 500, 501; and *Chapman et al. v. Wintroath,* 252 U. S. 126, 137.

The failure to follow established rules of law established by this Court is reason for granting certiorari.

III.

Conflict with a decision of this Court: an infringer who either uses the invention of the patent in suit with an improvement, patented or unpatented, or uses the patent in suit and reduces its effectiveness by some addition, contamination or deletion, cannot escape infringement. This Court has so held as above in Temco Electric Motor Company v. Apco Manufacturing Company, 275 U. S. 319, etc.

The mere fact that the infringer uses a mere 15% carbon dioxide, which the patents in suit indicate may be done without interfering with the main action of nitrous oxide, and so found in Finding 5, Vol. I, R. 72 by the District Court, cannot excuse the infringer from infringement.

The mere fact that the infringer uses a third party's later patent on such a mixture as an alleged improvement or as a basis for claiming a different combination of gases is immaterial as this Court has held frequently that the improver, who is an infringer, cannot thereby escape his infringement. *Kinsman v. Parkhurst,* 18 How. 243, 247

(Continued from preceding page)

ence to a later continuation application. This latter ruling is contrary to the Second Circuit decision in this litigation which used the later article by the inventor as anticipation of his earlier application and its continuation application maturing into the patents in suit. Such is also the same rule in the Second Circuit Court of Appeals in *Richardson v. Ruberoid Co.,* 30 F. (2d) 232, 234 (Judge Learned Hand).

(1855).[22] *Temco Electric Motor Company v. Apco Manufacturing Company*, 275 U. S. 319.

A later patent cannot defeat an earlier patent on either non-infringement or validity. The Court of Appeals of the Second Circuit even went so far as to find anticipation of the Getz method patent in suit, No. 172, because Getz wrote an article *after* his patent application was filed disclosing additional unexpected properties of nitrous oxide in cream based upon his continuing research.

IV.

Summary of the Conflict between Courts. The District Court, Western District of New York and the Eighth Circuit Court of Appeals agree on validity of process patent 172; and the Eighth Circuit Court of Appeals holds the product patent 862 valid. That patent was not an issue in the Second Circuit Court of Appeals.

The District Court for the Eastern District of Missouri and the Second Circuit Court of Appeals agree that patent 172 was invalid, but infringed (in the Second Circuit Defendant used all nitrous oxide and in the Eighth Circuit the Defendants used 85% nitrous oxide and 15% carbon dioxide, the District Court finding that this contamination did not affect the nitrous oxide).

The Second Circuit Courts of Appeal and the District Court in Missouri agree on infringement.

The Court of Customs and Patent Appeals, sustaining the universal judgment of all tribunals in the Patent Office, as to patent 172 and the District Court for the Western District of New York agree that the abandoned application, Serial No. 710,236, upon which the patents in

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[22] This rule against claiming an exemption from infringement because of a license under a third party's patent has been established by this Court over a period of nearly 100 years.

suit 172 and 682 are founded as continuations-in-part is one continuous application pursuant to the decisions of this Court in *Godfrey v. Eames,* 1 Wall. 317; *Smith v. Goodyear Dental Vulcanite Company et al.,* 93 U. S. 486, 500, 501; and *Chapman et al. v. Wintroath,* 252 U. S. 126, 137.

Contrary to the foregoing cases the Eighth Circuit Court of Appeals held the abandoned application (secret) could be used as a publication or as grounds for estoppel to prove noninfringement. The Second Circuit Court of Appeals used the abandoned application as a prior publication to prove invalidity. Both Courts use the application to show dedication of the subject matter of the combined gases. Such holdings are contrary to your decisions.

V.

Conflict with Decisions of this Court that there is no prevision in chemistry. The Second Circuit Court of Appeals held that, as in mechanics, the use of CO_2 or N_2O was a matter of selection of either a sour or sweet gas, **ignoring the fact that invention was in the discovery of unexpected properties of N_2O, not predictable from the literature, and securing results not possible with CO_2.** That is why this Court in *Corona v. Dovan,* 276 U. S. 358, 368, 369, established the rule pursuant to Statute R. S. 4888 that there is no prevision in chemistry.

In chemical cases, the Statute R. S. 4888, 35 U. S. C. A., Section 33,[23] has a different rule in mechanical cases

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[23] "Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, *compound,*

(Continued on following page)

than in chemical cases, as set forth in the language of the Statute. In mechanical cases, the patentee must point out in the patent why it distinguishes from other inventions and the principle thereof, *but in other cases such as chemical cases, it is only necessary to make a disclosure how the product can be made or the process can be practiced without regard to the knowledge of the principle on which the application is founded.* (See footnote.)

Getz' abandoned application claimed any gas to whip cream, claims 3 and 4; it claimed a mixture of carbon dioxide and nitrous oxide, claims 2, 7, 9, 11, 13; and it claimed carbon dioxide alone, claims 1, 5, 6, 8, 10, 12, 14. (Vol. III, D. Exh. 11.)

This Court recognizes that in chemical cases, there is no prevision. *Corona v. Dovan,* 276 U. S. 358, 368-9. This Court contrasted this different principle in chemical cases from mechanical cases just as the Statute R. S. 4888 draws this distinction. This Court has recognized that all the reasons for success and results from a chemical phenomenon may not and need not be known when the application is first filed. It follows Statute R. S. 4888 in so holding.

That is what has happened in this case. The original application was filed before the inventor had completed all his research work and he then filed his continuation-in-

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(Continued from preceding page)

and use the same; and **in case of a machine,** he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible. R. S. § 4888; March 3, 1915, c. 94, § 1, 38 Stat. 958; May 23, 1930, c. 312, § 2, 46 Stat. 376."

part applications when he had acquired greater knowledge of the unexpected properties of using nitrous oxide alone or with a small proportion of carbon dioxide. It is for that reason this Court has always encouraged prompt filing of a patent application and continuation-in-part applications when a more perfect knowledge of the invention was acquired, *treating the original abandoned application as one continuous application with the continuations-in-part.*

The Second and Eighth Circuit Courts of Appeals in treating the abandoned application, Serial No. 710,236, of Getz, as a wholly independent publication or dedication, contra to Statute R. S. 4888 and this Court's decisions. It is a matter of grave public importance that this Court's decisions be enforced *because otherwise no inventor would dare to file his patent application until after the most extensive research had been conducted. He could not file continuation-in-part applications and often he would not file any application at all because the subsequent disclosures of further research and practical use which always continue would prevent him from filing an exhaustive, complete and final application in the early stages of his invention.*

If he filed it later when all was known, it would then be too late.

The decisions of the Second and Eighth Circuit Courts of Appeals in disregarding this Court's decisions have lead to an impossible and disastrous situation in this new industry which, if unchallenged by this Court and uncorrected by this Court, will lead to grave industrial consequences. Our only relief is in your hands.

PRAYER.

Wherefore, your Petitioner respectfully prays that writ of certiorari be issued to the Circuit Court of Appeals for the Eighth Circuit to the end that this cause may be reviewed and delivered by this Court in accordance with the principles of law heretofore announced by it; and that the decree of the Eighth Circuit Court of Appeals be reversed as to non-infringement, and that the errors and conflict between Circuits be resolved in accordance with this Court's decisions; and that the Petitioner be granted such other and further relief as may be deemed proper.

AERATION PROCESSES, INC.,
By H. A. TOULMIN, JR.,
Counsel for Petitioner.

HUGH M. BENNETT,
MARION S. FRANCIS,
Of Counsel.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

The decisions below are listed, as reported, on pages 8 to 11 of the petition. The findings of the District Court for Eastern District of Missouri are printed in Vol. I, pages 70-77. A certified copy of the opinion of the Eighth Circuit Court of Appeals is attached to Vol. I of the Record.

JURISDICTION.

Petitioner would invoke the jurisdiction of this Court under § 240(a) of the Judicial Code as amended by the Act of February 13, 1925, U. S. C. A. Tit. 28, Sec. 347, to review the judgments of the Courts below and their conflict with each other and the decisions of this Court. The instant litigation arises out of charging of infringement of the process patent of Getz 2,294,172 of Aug. 25, 1942, and product patent 2,435,682 of Feb. 10, 1948, based upon application, Serial No. 710,236 filed February 8, 1934.

The Rule and cases believed to sustain jurisdiction are:

Conflict of Circuit: Supreme Court Rule 38(5)(b); *City of New York v. Saper, Trustee in Bankruptcy,* 336 U. S. 328, 329; *Robertson & Kirkham "Jurisdiction of the Supreme Court of the United States,"* page 629, § 322; *Stern & Gressman, "Supreme Court Practice,"* pages 100-101.

Court of Appeals Misapplied Supreme Court Opinion: *McCandless, Receiver v. Furlaud et al.,* 296 U. S. 140; *Upshaw v. United States,* 335 U. S. 410.

Inter-Circuit Conflict: *John Hancock Mutual Life Insurance Co. v. Bartels,* 308 U. S. 180; *Dickinson v. Petroleum Conversion Corp.,* 338 U. S. 507.

Statutory Issue: *United States v. Ruzicka et al., Trading as Seeley Dairy,* 329 U. S. 287.

Serious Hindrance to Effective Administration of Patent Law by Court of Appeals Decision: *Rothensies, Collector of Internal Revenue v. Electric Storage Battery Co.,* 329 U. S. 296.

STATEMENT OF CASE IN PETITION.

The foregoing petition contains a brief summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ as well as a statement of the questions involved in the case.[1] Additional facts are discussed in connection with the following argument.

SPECIFICATION OF ERRORS.

The specification of errors herein relied upon are those reasons incorporated generally in the reasons set forth in the Petition as grounds for its allowance.

The conflict in the Petition raises the following questions of law.

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[1] A cross-appeal was lodged by the appellee below raising substantially the same issues as in the main appeal.

I.

Conflict between Circuit Courts of Appeal: District Courts and Circuit Courts: Circuit Courts of Appeal and Court of Customs and Patent Appeals and Administrative Procedure of Patent Office: and conflict with this Court's decisions by contra holdings of Courts of Appeal.

The conflicts are stated in detail in the Petition for Certiorari. (pp. 5-7.)

We urge grant of certiorari to settle these questions pursuant to Supreme Court Rule 38(5)(b). The authorities are set forth in this brief, p. 11, etc., and need no repetition.

II.

A patent cannot be defeated as to validity or infringement by using the original application, held by this Court to be continuous with later continuation-in-part applications, as if it were prior art, a prior publication or an estoppel to claim infringement.

Dr. Getz was a young student at the University of Illinois working for his Ph.D. degree in very modest financial circumstances earning his keep in the Dairy Department of the University. His hunger led his inquiring mind to try gases to whip cream to get a more palatable diet. As Dr. Sommer,[2] Professor of Dairy Technology at the University of Wisconsin, said:

> **"* * * as of that date of March 15, 1932, to my personal knowledge, there had not been any gases successfully used for the purpose of aerating whipped cream and I had never heard of carbon dioxide gas being used for that purpose, nor had I ever heard of nitrous oxide being used for the purpose."** (R. 87.)

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[2] Author of the leading works in this Dairy field.

In the course of these trials, he perceived that nitrous oxide, "laughing gas," had unexpected properties not predicted by the books; carbon dioxide or other gases he tried would give some results but he saw it was a new and promising field with N_2O to solve the toughest problem of the dairy industry. "In fact, whipping cream is probably the most troublesome single product of milk distributors." (Vol. I, Sommer R. 85.) Based upon his then incomplete knowledge, he filed application Serial No. 710,236, on February 8, 1934, claiming nitrous oxide alone, any gas of this class alone, or a combination of nitrous oxide and carbon dioxide.

Getz filed his first application because he saw how to push back the frontiers in physical chemistry and because he secured practical results not predictable from all known published data on the properties of these gases, particularly N_2O. **It took genius to perceive how to use an anesthetic as food.**

Later he filed the process continuation-in-part application, patent 2,294,172, filed September 26, 1935, based upon later research. He filed his process patent when his later experience and experiments taught him nitrous oxide had other unexpected properties not found in other gases, but he stated in that application small amounts of other less effective and cheaper gases such as carbon dioxide would not affect the principles of his discovery.

He set forth promptly to the world his discovery of additional new results in a scientific article, "Instant Whipping of Cream by Aeration" (Vol. II, P.X. I) in "Food Research." He filed his product application as a division of patent 172, maturing into patent 682.

These transactions were continuous. The early application cannot be used for either anticipation or limitation of the scope of the patents based upon the early

application where there was no dedication of the subject matter of the two gases, under the doctrine established by this Court. *Godfrey v. Eames*, 1 Wall. 317; *Smith v. Goodyear*, 93 U. S. 486, 500, 501; *Chapman, et al. v. Wintroath*, 252 U. S. 126, 137; "Walker on Patents," Deller's Ed., Vol. II, pp. 873-877; R. S. U. S. 4888, U. S. C. A. Tit. 35 § 33.

Getz warned in each patent that the use of CO_2 gave adverse results and cautioned to use it in a minor capacity —the face of the patents show this warning.

The Circuit Courts, contrary to this Court's repeated decisions, used this secret original application as if it were published prior art, but at no time did Getz abandon N_2O or use of some minor amount of CO_2 with the major N_2O—that is in documentary form in public records in the Patent Office.

If the Second Circuit Court of Appeals had followed your rule, there would have been no holding of invalidity and the Eighth Circuit Court of Appeals would have held infringement.

Getz was a pioneer in a new field, creating a new industry by his trial work and his perception of unexpected results. No inventor is required to do more than make a complete disclosure in his patent to teach the public how to use his invention—the fact that he does not know all about his invention and its possibilities is immaterial. *Eames v. Andrews*, 122 U. S. 40; *Diamond Rubber Company of New York v. Consolidated Rubber Tire Company*, 220 U. S. 428, 435; *Beidler v. United States*, 253 U. S. 447; *Permutit Co. v. Graver Corporation*, 284 U. S. 52, 58-9, 60; "Walker on Patents," Deller's Ed., Vol. 2, pp. 756-7; p. 1228.

Getz pushed back the frontiers of physical chemistry. He is entitled to his reward for his perception and public

service. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 154, 155, 156.

III.

Infringement cannot be avoided by reduction in effecting contamination, addition or improvement, patented or unpatented.

This Court established in *Temco Electric Motor Company v. Apco Manufacturing Company*, 275 U. S. 319, the foregoing and followed the same rule in subsequent cases.

Particularly, where the patentee warns in his case against using CO_2 in toto and clearly states that a little of CO_2 will not hurt the action of N_2O, what excuse can there be for the Eighth Circuit Court of Appeals holding 15% CO_2 void if when 85% N_2O of the patent is still used and Finding 5, Vol. I, p. 72 states that 15% CO_2 is too little to have any effect.

IV.

There is no prevision in Chemistry.

Thus, held this Court in *Corona v. Dovan*, 276 U. S. 358, 368-9, following R. S. U. S. 4888, U. S. C. A., Title 35, § 33.

Getz tried the known gases reported in the literature: he perceived and discovered new and unexpected properties of equal solubility in water, serum and butterfat, high overrun, great stability, etc.

The Second Circuit Court of Appeals said it was a mere matter of taste in selection, but, obviously, *the de gustibus doctrine* had nothing to do with it.

It was not the sweet taste of N_2O that caused this unusual result—it was the unknown properties of "laughing gas" that caused the new reactions. In that, the Eighth

Circuit Court of Appeals was correct and the District Court at Buffalo was correct.[3]

V.

The ability to see the possibility of "laughing gas," N_2O, anesthetic of dentistry and surgery, as a food product and the perception of new properties in the new relationship was an invention of high order.

The price of success in patents has been that the inventor show vision, ingenuity and courage in trying to achieve new and unexpected results. **That is pushing back the scientific frontiers.**

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[3] Judge Knight said:

"The Getz invention did not result from a mere deduction from the known properties of nitrous oxide gas. It required much experimenting. 'In chemistry one cannot anticipate a result. A result may be obtained only by experiment.' *United Chromium v. International Silver Co.*, D. C. 53 F. 2d 390, 393, modified but affirmed, 2 Cir., 1932, 60 F. 2d 913. 'Chemistry is essentially an experimental science, and chemical prevision is as impossible today, in spite of the accumulation of the great knowledge, as it was in former times.' *Gen. Electric Co. v. Laco-Philips Co.*, 2 Cir., 233 F. 96, 103. As Mr. Justice Holmes said in *Minerals Separation v. Magma Co.*, 280 U. S. 400, 403, 50 S. Ct. 185, 186, 74 L. Ed. 511: 'There is no "of course" as to what nature can do, except as proved by observation and experiment.'

"Defendants have made no convincing proof that the results obtainable by the Getz patent were known to the prior art or could have been predicted by chemists expert in this particular field. **The discovery of Dr. Getz revealed 'the flash of creative genius not merely the skill of the calling.'** *Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91, 62 S. Ct. 37, 41, 86 L. Ed. 58.

"In *B. G. Corp. v. Walter Kidde & Co., Inc.*, 2 Cir., 1935, 79 F. 2d 20, Judge Learned Hand said: 'All Compositions are made of the same substances, retaining their fixed chemical properties. But the elements are capable of an infinity of permutations, and the selection of that group which proves serviceable to a given need may require a high degree of originality. It is that act of selection which is the invention; and it must be beyond the capacity of common-place imagination.' Page 22 of 79 F. 2d.

"The Getz invention apparently meets this test. It met a general need and has become a great commercial success. * * *"

Aeration Processes v. Walter Kidde & Co., 77 F. Supp. 647, 651, 652. (D. C. W. D. N. Y., 1948.)

And when you combine with that accomplishment the **inspiration to use an anesthetic for a food,** and to use a product, that sends human beings into wild laughter or unconsciousness, as a food, you do, indeed, have the "touch of genius."

CONCLUSION.

We submit this case should be reviewed, the conflicts settled and the national reward be granted to this scientist for his youthful creation of a new industry.

To hold the use of an ineffective, cheap contaminant can avoid the patents in suit is to defeat them for all practical purposes.

We earnestly submit this Court should order up this case.

Respectfully submitted,

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Of Counsel

FILED
SEP 2 - 1952
CHARLES ELMORE CROP
CLE

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, A. D. 1952.

No. 239.

AERATION PROCESSES, INC., a Corporation,
Petitioner,

vs.

LOUIS A. LANGE and JOSEPH B. WINKLER, etc., et al.,
Respondents.

Petition for Writ of Certiorari to the United States Court of Appeals for the Eighth Circuit.

RESPONDENTS' REPLY TO PETITION FOR WRIT OF CERTIORARI.

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Respondents.

Petition for Writ of Certiorari to the United States Court of Appeals for the Eighth Circuit.

RESPONDENTS' REPLY TO PETITION FOR WRIT OF CERTIORARI.

PARTIES AND ISSUES.

This cause comes before this Court on a Petition for a Writ of Certiorari to the Court of Appeals for the Eighth Circuit to review the proceedings of that court in a patent case holding Petitioners' two Getz patents valid, but not infringed by respondents or any of them, R. I, 338. One of these patents (on process) was held invalid in the Second Circuit (170 F. 2d 437), that appellate court finding no

NOTE: In this brief, all emphasis and parts in parenthesis in quotations are ours.

need to consider the question of infringement; the other patent (on product) was not before the Second Circuit Courts and has never previously been adjudicated.

Respondents ask denial of the Writ. Respondents have not filed a Cross Petition.

The patents are No. 2,294,172 for a process, hereinafter referred to as the Process Patent, and No. 2,435,682 for a product, hereinafter referred to as the Product Patent.

Petitioner offers both patent issues, infringement and validity, because of alleged "Conflict Between Courts" (emphasized p. 1 of petition).

It is submitted that these issues should be considered separately by this Court, in passing on the petition, because different facts and circumstances are involved.

The Issue of Validity.

This petition is brought by the party successful below on the question of validity.

The petition has not cited, and we have not found, any case in which this Court has allowed certiorari to the party **successful below on an issue** (here, validity) for the purpose and effect of reviewing an unfavorable decision on such an issue in **another Circuit** to which no Writ has been sought, and for which Writ the time has now long passed.*

While the defense of invalidity is open to a respondent, when certiorari is granted on the issue of infringement,

* The decision of the Court of Appeals for the Second Circuit is dated November 1, 1948, remanding the case to the District Court to consider assessment of attorneys' fees, 170 F. (2d) 437, 439; the first Mandate is dated November 17, 1948; the Mandate dated December 6, 1949 taxed costs in the District Court; the District Court Final Judgment dated January 26, 1950 notes agreement in and payment of costs and attorneys' fees; there was no further appeal. It is believed that petitioner will agree to the above statement, without requiring respondent to file certified copies of the above.

Petitioner here has no proper standing for a writ based upon a favorable holding of validity below.

The Product Patent has not heretofore been adjudicated (petition p. 10 top, p 15 IV); and there is no conflict of opinion on it.

The Defendants in the Second Circuit, successful on the issue of invalidity of the Process Patent, are **not in this Court** to urge their case.

The petitioner is in the position that, unless the issue of infringement is present, the question of validity is moot as to these respondents, for the reason that they have been held not to infringe and should not again be put to trial.

The Issue of Infringement.

The primary prayer (Petition, p. 19) is on the question of infringement, the Court of Appeals for the Eighth Circuit having found both patents valid but not infringed. Petition, p. 1, par. 1 seeks "to review the decree of that Court, contrary to the decisions of this Court, holding the claims in issue" of the patents "not infringed." We will therefore practically limit this response to the discussion of that question.

The Product Patent has not heretofore been adjudicated (Petition, p. 10 top, p. 15 IV), and there is no conflict of appellate decision upon it.

The Process Patent was not adjudicated as to infringement by the Court of Appeals for the Second Circuit. The District Court decision, 77 F. Supp. 647, shows that the defendants there employed **nitrous oxide**, the gas specified in the Process Patent, and **not** the gaseous **mixture** of carbon dioxide and nitrous oxide used by the defendants in the Eighth Circuit, petition, pp. 4-5. Here that mixture is held to be definitely and critically distinct from the gas described and claimed in the patents, R. I, 347-348.

No questions of restricted claims, or of file wrapper limitation of claims, or of abandonment of description and claims to such mixture, or of adverse intervening rights, on which the decision of non-infringement was based in this case, were present in the Second Circuit.

Before demonstrating the above points, we want to supplement the statements of facts in the petition.

SUPPLEMENTAL STATEMENT OF FACTS.

The Court of Appeals for the Eighth Circuit in its decision, R. I, 341, denominated the subject matter of the patents as residing in a process (process patent), involving incorporating, in cream, nitrous oxide under pressure in a siphon bottle, and pressing the button of the bottle to release the cream as whipped cream, which is the product of the product patent. It is to that process and product to which the Court of Appeals restricted the patents, and, accordingly, found no infringement by the employment of a mixture of carbon dioxide and nitrous oxide, R. I, 346-348.

Petitioner filed the following Getz applications: Serial No. 710,236, filed February 8, 1934, R. III, 236, and which became abandoned, September 29, 1935, and hereinafter designated as the abandoned application; Serial No. 42,225, filed September 26, 1935, and which matured into the Process Patent No. 2,294,172 August 25, 1942, R. II, 1; and Serial No. 445,486, filed June 2, 1942 and which matured into the Product Patent No. 2,435,682, R. II, 152.

The Diller Patent No. 2,155,260 issued April 18, 1939, on an application filed December 29, 1937, R. III, 415, and was assigned to the S. S. White Dental Manufacturing Company, R. III, 432. It was referred to by the Court of Appeals R. I, 347, 348.

While the Court of Appeals considered the case as directed to the whipping of cream with nitrous oxide, both

patents include generally the aeration of an "edible-fat-containing liquid" and an "aerated fat-containing food product."*

The specifications of both patents specify **nitrous oxide**, which is described in the specifications of the patents as an "**inert** water-soluble **non-acid forming** gas," as distinguished from carbon dioxide "which reacts with water to form free carbonic acid."**

The claims of the patents specify the employment of a gas, defined as an "**inert** water-soluble **non-acid forming** gas" or "a non-acid forming gas which is soluble * * *," or "nitrous oxide," described supra as "an inert water-soluble non-acid forming gas."

The claims of the Getz **abandoned** application R. III, 236, viz., Claims 3 and 4 (file p. 7),*** specified broadly:

"**a water-soluble gas.**"

After abandonment of that application, the application R. II, 8 of the Process Patent again claimed, viz., claim 4 (file p. 8), the gas broadly as "**water-soluble.**" After action on (citing prior art) and rejection of that and other claims (file pp. 11, 15), that claim was amended (file pp. 13 and 19) to specify as appears by interlineation (file p. 8) an

"**inert** water-soluble **non-acid forming** gas."

That claim 4 became claim 1 of the process patent.

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* Process Patent R. II, 1 left, line 4 and Claim 1; Product Patent R. II, 1, 152 left, line 5 and Claim 5. The Process Patent enumerates food products other than cream, p. 2, right, even "ice cream mixes" p. 1, left, line 13; so also the Product Patent specified even "ice cream" R. II, p. 153, right, line 74.

** Process Patent R. II, 2, right, lines 21, 13, Claim 1; Product Patent R. II, 154, Claim 2. The patents also specify gases other than nitrous oxide, viz., acetylene, difluor-dichlor-methane, etc., which however are all described as "non-acid forming and inert," R. II, 2, right, line 27; R. II, 153, right, line 61.

*** The notation "file" refers to the pages of the file of the abandoned application and to the file of the application of the Process Patent shown at the bottoms of the photostat copies.

The specification (file p. 6) was amended to the same effect as appears by interlineation and by directing amendments (file pp. 13 and 18). In so amending, petitioner, referring to a conference with the Examiner, specifically stated (file pp. 19-20):

> ". . . Objections to the use of carbon dioxide in addition to the taste, such as creating or increasing acidity of milk as measured **by pH value**, were also mentioned at the meeting. The specification and Claim 4, have been amended to point out that a **non-acid forming** gas is used. The other claims are limited to nitrous oxide which does not form acid under the conditions of use, and does not give a sharp taste."

All of the other claims of the Process Patent specify "nitrous oxide," described as noted above, as "a non-acid-forming gas," as was also described "difluor-dichlor-methane" of claim 6.

The expression "non-acid forming gas" was carried into the second patent in suit, No. 2,435,682, R. II, 154, claim 5.

The above is substantially in Finding (14), R. I, 76.

The **earlier** Process Patent (granted 1942) does **not** refer to mixtures of gases (as did the abandoned application); the **later** Product Patent (filed 1942) **after the adverse** rights from grant in 1939 of the Diller Patent,* states R. II, 153 right, line 46, etc., that "nitrous oxide need not be used in pure form" and refers to a "**minor** amount of carbon dioxide mixed with nitrous oxide." Such carbon dioxide as an impurity is on the order of "**less than 1%**" and "**a small fraction of 1%.**" In that proportion there is

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* Enumerated by the Court of Appeals, decision R. I, 348, as one of the "patents for use of the mixture (have been) granted to others." The others' patents are Goosmann Patents Nos. 2,217,678 of 1940, R. III, p. ..., and 2,250,300 of 1941 (filed 1940), R. III, p. ... All those patents are owned by The S. S. White Dental Manufacturing Company.

no acid or biting taste.** Even this Product Patent,*** R. II, p. 153, right, lines 53-54, says: "Its use, however, is **not** recommended in an edible aerated cream."

Respondents' mixture containing 15% carbon dioxide has more than **15 times** the acid component as was deemed permissible in the Product Patent. Moreover, Dr. Sommer, Petitioner's witness, admitted on cross-examination, R. I, 154:

> "A mixture containing 85% nitrous oxide and 15% carbon dioxide is **definitely not inert, non-acid forming.**"

As above quoted, p. 6, supra, before the Patent Office, Petitioner asserted that the measurement of "acidity" with reference to "taste" is "measured by the **pH value**". Petitioner's witness, Dr. Sommer, performed a series of tests in court by charging three siphon bottles containing cream at 80 and 100 lbs. pressure, respectively, with nitrous oxide, carbon dioxide, and respondents' mixture of 15% carbon dioxide and 85% nitrous oxide. He took the pH values. On cross-examination, on the basis of those pH values, Dr. Sommer admitted the following: that cream charged with that mixture is from **5.8 to 6.1** times as acid at 80 lbs. and 100 lbs., respectively, as is the same cream charged with nitrous oxide alone; while at the same pressures, cream charged with carbon dioxide alone is only from **4.6 to 5** times as acid as is cream charged with the mixture. Dr. Sommer's concluding admission (on cross-examination, R. I, 177), in question and answer form, was as follows:

> "Q. **There is no doubt** about it that cream containing the mixture 15 per cent carbon dioxide and 85

** Dr. Smith, Petitioner's President, R. I, 284, 299; Dr. Sommer, Petitioner's witness, R. I, 153-154—on cross-examination.

*** Filed over three years after the issue of the Diller patent 2,155,260, R. III, 415, describing the employment of carbon dioxide—nitrous oxide mixture.

per cent nitrous oxide is **a good many times as acid** as a cream containing nitrous oxide alone? A. In the charged condition, **that is right.**"*

The above is what is stated in Finding 5, R. I, 72, quoted by the Court of Appeals, decision, R. III, 346-347. On that basis, the Court of Appeals said (decision, R. I, 348):

". . . The product from the use of the mixture is **many times as acid** as the product of N_2O (nitrous oxide) alone. The mixture is a departure from the Getz patents' teaching. The court erred in ruling in the alternative that defendants infringed if the patents were valid."

That accords with the claims of both patents which specify a "**non-acid forming** gas", or "nitrous oxide", so also described; and the claims were so restricted by amendment. We will show, p. 17, infra, that the Court of Appeals decision is in accord with this Court's decisions. The Court practically quotes Dr. Sommer's admission.

The petition points to the concluding part of Finding 5 quoted in the Court of Appeals, R. I, 346-347, and reading as follows:

"but from the practical standpoint of taste, it is not discernible as acid."

That statement is apparently based upon the testimony by Petitioner's witness, Dr. Sommer, R. I, 178. However, Dr. Sommer's views are more fully stated on rebuttal cross-examination, R. I, 239. First, Dr. Sommer testified that **neither patent in suit tells** anything about how one determines whether something is non-acid forming; although as noted, p. 6, supra, the Examiner was told that the determination even as to taste was by the meas-

* Later on, Rebuttal R. I, 233, etc., Dr. Sommer compared the cream as dispensed and found and admitted, R. I, 258, that cream charged with the mixture (carbon dioxide, nitrous oxide) is approximately 4.4 times as acid as cream charged with nitrous oxide alone.

urement of the pH; and although Dr. Sommer took great pains in comparing bottles charged with cream and, respectively, with nitrous oxide, carbon dioxide, and respondents' carbon dioxide—nitrous oxide mixture, by measuring the pH. However, after it was shown, that based on the measurement of pH, the mixture charged cream was **5.8 to 6.1** times as acid as cream charged with nitrous oxide alone, R. I, 177. Dr. Sommer, then, R. I, 239, resorted to "the criterion of the patent is taste" determined by him as a one-man poll of public opinion.

The Court of Appeals rejected that criterion, and so has this court in similar cases, p. 18, infra.

As stated in the Court of Appeals decision, R. I, 347-348, petitioner "unequivocably and knowingly abandoned all claim" to a mixture of carbon dioxide and nitrous oxide. That is substantiated by the proceedings in the Patent Office. The February, 1934, **abandoned Getz application,** R. III, 236, specifically described (file, pp. 5, 6) and specifically claimed (file, pp. 7, 8) in Claims 2, 7, 9 and 13, the employment of **a mixture** of nitrous oxide and carbon dioxide for aerating cream and other liquids. That is admitted, petition, p. 17. Upon refusal of such claims by the Examiner (file, pp. 11, 17-18) that application became abandoned September 30, 1935, and its abandonment is noted on the first page of that file. Four days before such abandonment became effective, namely, on September 26, 1935, petitioner filed its substitute application, R. II, 8, for the Process patent. That application, however, **deliberately left out** all **claims** and even all **descriptions** of the employment of such a gas **mixture**; indeed, that application, as well as the patent, has asserted carbon dioxide as being undesirable. It was on that 1935 application that the Process Patent issued in 1942.

Neither the application, R. II, 70, for the Product Patent filed June 2, 1942, nor the patent itself, **contains any de-**

scription of the employment of such a **mixture**, but again asserted carbon dioxide as undesirable, mentioning it only as a **permissible** ("minor") impurity, R. II, 153, right, lines 49, etc., which is **"less than 1%"** or even a **"small fraction of 1%"** as admitted by Plaintiff's President, Dr. Smith, R. I, 299, and by Dr. Sommer, R. I, 154. Moreover, that reference to a permissible ("minor") impurity appeared in the application **over six years after** claims and even description to the mixture had been left out of the application of the Process Patent, and over six years after the first Getz application became abandoned.

The above is substantiated by Finding 14, R. I, 76. **The Diller Patent** 2,155,260, R. III, 415 (filed December 29, 1929), issued April 18, 1939, **over three years** prior to issuance of the Process Patent and over three years before the filing of the Product Patent application. That Diller patent described as well as claimed the employment of a carbon dioxide-nitrous oxide **mixture** for the aeration of cream. **No interference** was instituted by the Patent Office or asked for by petitioner, although it had constructive notice of that patent for years.

The Court of Appeals says in its decision, R. I, 348:

> ". . . He (Getz) discovered that it (nitrous oxide) worked and he advanced the art. He rightly claimed invention and got his patent. But he abandoned the claim he had made to a mixture of nitrous oxide and carbon dioxide to produce whipped cream. He identified the mixture of the gases as one that he knew of and had considered for his purpose, but he stood on his abandonment of it through all the years of Patent Office proceedings. He shows no right to any monopoly in respect to the mixture to which he unequivocally and knowingly abandoned all claim. Patents for use of the mixture have been granted to others, as found

by the court (see Patent 2,155,260),* and others have long used the mixture . . .''

That decision is not only supported by the record, but is supported by this Court's decisions, p. 16, infra.

The Diller Patent No. 2,155,260, R. III, 415, not only describes and claims the employment of respondents' gas mixture of carbon dioxide and nitrous oxide in the aeration of cream, but states **distinct advantages**, namely, avoiding the tendency of the cream breaking down upon exposure and obtaining a product which is more stable by virtue of acidity imparted by the carbon dioxide part of the mixture. That stability was demonstrated in Court, in fact, by Petitioner's witness, Dr. Sommer, as follows:

The three bottles of cream charged respectively with nitrous oxide, carbon dioxide, and respondents' mixture, were kept in Court overnight. While Dr. Sommer was being cross-examined, one of the bottles exploded, R. I, 161. On being asked by respondents' counsel to report which sample exploded, Dr. Sommer answered that it was the nitrous oxide-charged cream which had exploded, R. I, 166. The mixture-charged cream did not explode and neither did the carbon dioxide-charged cream.

The superiority of the mixture-charged cream is also substantiated by the data given in the Getz abandoned application, R. III, 236. It shows, file pp. 4-6, that the mixture-charged cream is distinctly superior over both the nitrous oxide-charged cream and the carbon dioxide-charged cream. Thus, the nitrous oxide-charged cream at 80 lbs. had an over-run of 230% and a drainage of 36%; the carbon dioxide charged cream at 92 lbs. had an over-run of 320% and a drainage of 8%; the mixture charged

* The validity of the Diller patent issued April 18, 1939, filed December 29, 1937, is not involved here and was only referred to to show adverse rights by others after the abandonment of the mixture claim in September, 1935.

cream at 75 lbs. had an over-run of 360% and a drainage of only 7%.

The Court of Appeals said, R. I, 348:

> ". . . The specified percentages of the gases in the mixture used by defendants make it a real and substantial mixture of two gases, differing from either one of the constituent gases and defendants' use of the mixture of gases to produce whipped cream does not come within the scope of the Getz patents nor infringe them . . ."

The above is substantiated by the record in this case, namely, by the evidence produced by the **petitioner's own witness**, Dr. Sommer, and by petitioner's **abandoned application.** This case does not involve a mere colorable evasion by adulterating nitrous oxide, or a simple and obvious change by the use of respondents' mixture as distinguished from nitrous oxide, but shows **a combined action** operating on an entirely **different principle.**

ARGUMENT.

The following decisions of this Court have denied petitions for writs of certiorari where there was no real conflict between Circuit Courts of Appeal: Layne and Bowler Corporation v. Western Well Works, Inc., 261 U. S. 387;* Keller v. Adams-Campbell Co., 264 U. S. 314; General Talking Pictures Corp. v. Western Electric Co., 304 U. S. 175.

In General Talking Pictures Corp. v. Western Electric Co., 304 U. S. 175, 178, this Court said: "Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it." That is really what Petitioner seeks on the question of infringement, because there is **no conflict on infringement** between the Second and Eighth Circuits.

Law Questions on Validity.

Petitioner cannot seek a review of the Second Circuit decision, because, first, the defendants there are not parties to this petition; second, no review of the decision in that case can be had, because the time for the filing of the petition for a writ has expired.

What Petitioner really asks this Court to do is to give an advisory opinion or to pronounce a declaratory judgment on the validity of the Process and Product Patents, apparently to support the decision of the Court of Appeals for the Eighth Circuit holding the patents valid. That this Court will not do. Muskrat v. United States, 219 U. S. 346, 31 S. Ct. 250, 256; State of Alabama v. State of Arizona, 291 U. S. 286, 291, 54 S. Ct., 399, 401.

The Muskrat case involved a situation somewhat similar as we have in this case, because an advisory opinion on

* Citing, p. 393, U. S. v. Rimer, 220 U. S. 547; Furness, Withy & Co. v. Yang-Tsze Insurance Association, 242 U. S. 430.

the validity of an Act of Congress was asked, 31 S. Ct. 250, 256. This Court in dismissing the petitions said, p. 253, that the judgment must be "between persons and parties who bring a case before it for decision"; further, p. 255, that the judicial power is the right to determine actual controversy "arising between adverse litigants, duly instituted in courts of proper jurisdiction". While in that case, the United States was made a Defendant, this Court said, p. 255: "It has no interest adverse to the claimants".

There are no decisions of this Court in patent causes applying directly to this question, namely, of an attempt to obtain an advisory opinion or to pronounce a declaratory judgment, although this Court did refuse to go beyond the actions of the lower Courts in the following cases: Leeds and Catlin v. Victor Talking Machine Co., 213 U. S. 301, 311; Meccano, Ltd., v. John Wanamaker, 253 U. S. 136, 142. In the latter case, this Court refused to declare which of the expressed conflicting views of the Courts of Appeal was right.

The Circuit Courts of Appeals have refused to give an advisory opinion in the following patent cases: Cover v. Schwartz, 133 F. (2d) 541, 544, C. C. A. 2, certiorari denied, 319 U. S. 748; Zalkind v. Scheinman, 139 F. (2d) 895, 904, C. C. A. 2, certiorari denied, 322 U. S. 738; Signalite Fuse Co. v. Fuse Indicator Corporation, 174 F. (2d) 819, C. C. A. 3.

The petitioner's position is anomalous on the issue of validity, and we do not see what it hopes to accomplish. It asks review of a favorable decision.

It is apparent that if a writ of certiorari to the Eighth Circuit is granted, on the issue of validity, and petitioner then declares acceptance of the decision of validity below, the writ should then be dismissed for lack of controversy on validity; Norton, Deputy Com'r v. Vesta, 291 U. S. 641,

54 S. Ct. 376. If petitioner later does accept the decision of validity below, and if this Court should sustain the Eighth Circuit on validity, then the case will be as before because the patent has been held not infringed by respondents. If this Court should find the patents invalid, then petitioner will have gained nothing because an invalid patent cannot be infringed. It is apparent therefore that, on the question of validity, either affirmance or reversal will be profitless to petitioner, because it will leave unaffected the judgment brought here for review (which affirms dismissal of petitioner's complaint) and cannot dispose of the case; Flournoy v. Wiener, 321 U. S. 253; Murdock v. City of Memphis, 20 Wall. 590.

Petitioner's only purpose seems to be indirectly to obtain a review of the Second Circuit holding of invalidity, after the time for a direct petition to that court has expired, and without having the defendants there before this Court.

Forsyth v. Hammond, 166 U. S. 506, Petition p. 11, has no bearing on this case, because that involved annexation of territory, where there was actually such conflict between the decisions of the Courts of Appeals as to warrant this Court to entertain the writ. Likewise, the decisions cited in the petition, pp. 20 and 21, have no application here, and petitioner has not shown that they do.

Law Questions on Infringement.

On the question of infringement, the decision of the Court of Appeals for the Eighth Circuit is not in conflict with or contrary to the decisions of this Court, as asserted in the petition, p. 1, par. 1; p. 7 IV; p. 11; pp. 14-15 III; and p. 15 IV. The status of the Getz abandoned application as related to the applications of the patents will be separately treated, pp. 18 etc., infra.

The Court of Appeals, in its decision R. I, 346-348, concluded non-infringement on two grounds; namely: first, that petitioner "unequivocally and knowingly abandoned all claim" for the employment of mixtures of carbon dioxide and nitrous oxide; second, that the employment of respondents' mixture "does not come within the scope of the Getz patents" and that "the mixture is a departure from the Getz patents' teaching." The facts appear, pp. 5 etc., supra.

FIRST: as to the **abandonment** of employment of claims to a **mixture** of carbon dioxide and nitrous oxide; the decision of the Court of Appeals is in harmony with the decisions of this Court in the following cases: Schriber-Schroth v. Cleveland Trust Co., 311 U. S. 211, 218; Union Metallic Co. v. U. S. Cartridge Co., 112 U. S. 624, 625, 635, 643, 645; Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 152 U. S. 425. All of those cases involved cancellation of **restricted** claims. In the Schriber-Schroth and Morgan Envelope cases, the description had been retained, but in the Union Metallic case the **description**, as well as the claims of the particular thing had been **cancelled**. In all three cases, this Court considered the specific thing as not being included in the patent and, therefore, found no infringement.

The reference to the patent number 2,155,260 in the Court of Appeals decision, R. I, 348, is simply as showing that **adverse rights** had accrued. That is in accord with this Court's decision in Schriber-Schroth Co. v. Cleveland Trust Co., 305 U. S. 47, 57 and the decisions cited therein, and Crown Cork & Seal Co. v. Gutmann, 304 U. S. 159, 167.

The decisions cited in Petitioners' Brief, pp. 24 and 25, have no application here, because this case does not involve questions of a described thing and its possibility, but of **outright abandonment of claims and description** of a thing, particularly in the face of adverse rights.

The petition at many places (p. 10, footnote 18; p. 11, footnote 19; p. 14, last par.; page 15, line 3) refers to defendants as working under a "**later**" patent owned by The S. S. White Dental Mfg. Co. To be exact, the patent (Dillar, 2,155,260) was granted in 1939; while the Process Patent in suit was granted in 1942, and the Product Patent in 1948. Petitioner therefore had at least constructive notice of the Diller Patent from 3 to 9 years before its own patents issued. **No interference** was sought or declared therewith.

SECOND: what the Court of Appeals decided, decision R. I, 348, was that cream charged with respondent's mixture, which was from **5.8 to 6.1** times as acid as cream charged with nitrous oxide alone, constituted **a departure** from, and did **not** come **within the scope** of the patents in suit. As noted above, the claims define the gas as an "**inert** water-soluble **non-acid forming** gas" or "nitrous oxide," likewise so designated in the patents, and as distinguished from respondents' carbon dioxide—nitrous oxide mixture, which petitioner's witness, Dr. Sommer, admitted, "is **definitely not inert, non-acid forming,**" and which in cream is indeed "**a good many times as acid** as a cream charged with nitrous oxide alone," see pp. 7-8, supra.

Further, the claims were so restricted by amendment, p. 5, supra. The decision of the Court of Appeals is, therefore, in accord with the decisions of this court: where the claims are **restricted by their language**, Milcor Steel Co. v. Fuller Co., 316 U. S. 143, 145-146; where such restriction was by amendment after rejection by the Patent Office; I. T. S. Co. v. Essex Co., 272 U. S. 429, 430, 443; Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126, 137.

The decisions cited under IV, Petition, p. 7, and under III, Petition and Brief, pp. 14, 15, and 25, are not applicable here. The Court of Appeals did **not** conclude non-

infringement, simply because Respondents' carbon dioxide-nitrous oxide mixture for the aeration of cream differed from or constituted an improvement on the employment of nitrous oxide alone; or simply because respondent was operating under a patent for the employment of such a mixture. The Court of Appeals concluded non-infringement by the application of the principles of law as laid down by this court in the decision just cited. This decision is in harmony with and not in conflict with the decisions of this court.

The Petition is inconsistent as to the taste criterion as establishing infringement and set out in the last sentence of that part of Finding 5 quoted by the Court of Appeals, R. I, 346-347. Petitioner, while relying upon that taste criterion to establish infringement, Petition, pp. 7, 9 and 10, attacks, p. 8, the decision of the Court of Appeals for the Second Circuit in deciding that no patent can be based upon a taste criterion designated, 170 F. (2d), at p. 439, as "the empirically verifiable de gustibus doctrine." That view is amply supported by the decision of this Court in Holland Furniture Co. v. Perkins Glue Co., 277 U. S. 245, 250, 256, 257, which was cited and applied by this Court in General Electric Co. v. Wabash Co., 304 U. S. 364, 371, 373, and in United Carbon Co. v. Binney Co., 317 U. S. 228, 234. In the Holland case it was attempted to define a glue as "having substantially the properties of animal glue"; that was certainly more definite than seeking to define whipped cream by the De Gustibus doctrine and by a one-man public poll. Infringement, like validity, cannot be founded upon such a doctrine.

There Is No Conflict Concerning Continuity Right From an Abandoned Co-Pending Application.

The petition asks (p. 1, par. 1; p. 5, II; p. 6, III; pp. 8-9; p. 10; p. 11, I; pp. 12, 13; p. 15 bottom-16; p. 18) that

this Court should review the decisions of **both** the Eighth and Second Circuits, alleging conflicts with the decisions of this Court, with the statement that neither Circuit allowed continuity right to the abandoned application.

No such conflict is present.

In each circuit, the Process Patent was accorded full continuity right from the earlier abandoned application, **for all matter carried forward** into the substitute application of the Process Patent; for the mixture of carbon-dioxide and nitrous oxide was not carried forward but was deliberately left out. The Product Patent was not involved in the Second Circuit, but similar continuity was allowed in the Eighth Circuit, R. I, 341, 342, 346.

Continuity for matter carried forward is not, in fact, the basis of petitioner's plaint. Instead, it cavils that in the Second Circuit the Court also inspected the **rest** of the abandoned application and found that Getz had said that nitrous oxide and carbon dioxide were **equivalents**. It cavils, also, that, in the Eighth Circuit, the Court also inspected the **rest** of the abandoned application and found that Getz had originally disclosed a mixture of nitrous oxide and carbon dioxide, but had dropped and **abandoned claims as well as description to this mixture**; the Court then decided that Getz cannot now say that his present description and claims cover the mixture. That is not in conflict with decisions of this court but is precisely the course taken by this court in Schriber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211, and other cases cases cited, p. 16, supra. There is no conflict between the decisions in the Second and Eighth Circuits. The decision in the Second Circuit was based on an **admission** resulting in a conclusion of invalidity; the decision in the Eighth Circuit is based on **abandonment** of the mixture resulting in a conclusion of non-infringement.

The decision of the Court of Customs and Patent Appeals, also urged (pp. 12, 15 bottom and 22) by the petition as in conflict with the decisions in the Second and Eighth Circuits, simply involved a question of priority (not of scope or validity) between Getz and one Reineke,* but in all three cases, continuity was allowed **for the matter carried forward.**

Petitioner's contention is on a par with the position taken by the Government in U. S. v. Rimer, 220 U. S. 547, where the petition proceeded upon the basis that a decision below involved a principle of law of far-reaching importance; it, however, appeared that the action of the court below, when accurately tested, did not deal with that principle at all. The petition was dismissed, p. 548.

Petitioner urges (p. 18) that confusion exists, and conflict, so that inventors will fear to file original and continuation applications. Such is not the case. All the inventor need do is carry forward his entire description and claims, and then no abandonment exists. Here the carbon-dioxide-nitrous oxide mixture was not carried into either patent from the abandoned application, but all claims and even all description were deliberately left out of the patents.

Prevision in Chemical Cases.

The petition, page 16 V and the brief p. 25 IV, alleges that the courts have not properly applied the so-called doctrine of "lack of prevision in chemical cases."

The petitioner cannot urge such error in the Eighth Circuit, to which this writ is addressed, because the patents were there held valid and the appellate court specifically recognized "pre-vision" in a "chemical case," decision, R. I, 346.

* See Aeration v. Kidde, 170 F. (2d) 437, 439, right.

Petitioner's plaint is really directed against the Second Circuit decision, to which no petition for a writ is addressed. Even there the point appears idle, because that decision was based upon admission of the petitioner that the nitrous oxide and carbon dioxide are identical except in taste, 170 F. (2d) 437, 439, right.

Public Interest.

The petition urges great public interest (p. 2, par. 3; p. 5 I; p. 11 I; p. 11 bottom; p. 18).

No compelling public interest now claims the attention of this court.

Public interest appears at least no greater now than when the Second Circuit decision was made; and could then have been invoked by Petitioner for a writ against that adverse holding of patent invalidity. Apparently, all of the present suits were then pending.

The public in the Second Circuit presently regards the Process Patent as invalid. Query: Is it to the public interest to disturb that by an indirect ruling in the absence of the defendants there?

The Product Patent has not been tried in the Second Circuit or elsewhere than in the Eighth Circuit.

The public in the Eighth Circuit presently regards the employment of the mixture of carbon dioxide and nitrous oxide as non infringing. Query: Is it to the public interest to disturb that ruling of non-infringement in the absence of conflict?

The public elsewhere can follow the ruling of invalidity in the Second Circuit, or of non-infringement in the Eighth Circuit. Query: Should this court make an advisory ruling, without an actual controversy before it, to determine the

action of a court in a suit not yet tried, or even (petition, p. 2, par. 3; p. 5, I) potential litigation not yet brought?

Our answer to each of these questions is "NO."

It does not appear that the **general** public interest in the specific patents, or in the meaning of the patent laws is properly offered in issue before this Court as important for settlement here, as distinguished from the private interest of Petitioner, as stated, petition, p. 11, bottom, "This new business should be protected and its status established." In such a case, a writ has been dismissed; Layne and Bowler v. Western Well Works, Inc., supra; Keller v. Adam Campbell Co., supra.

This is not a case where the entire business of making whipped cream by the employment of a gas is concentrated in one circuit, from the decision of the Court of Appeals of which circuit Petitioner seeks review, as were the cases in Schreiber-Schroth Co. v. Cleveland Trust Co., 305 U. S. 47, 50; Schreiber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211; Exhibit Supply Co. v. Ace Patents Corp., 315 U. S. 126, 128; Muncie Gear Works, Inc., v. Outboard Marine and Gear Co., 315 U. S. 759, 760. Here, according to petition, cases have been tried in the Second and Eighth Circuits and are pending in the Seventh Circuit, p. 11, p. 5, footnotes 7 and 8.

Nor is it a case where the parties are such large operators that a suit against a third party appears unlikely; Mackay Radio Co. v. Radio Corp., 306 U. S. 86, 89.

CONCLUSION.

Since the petition emphasizes conflict of decisions by capital letters, on p. 1, it may be desirable to summarize the various conflicts alleged:

Conflict between Eighth Circuit and this Court on infringement: concerning effect of abandoned application:

(Petition, p. 1, par. 1; p. 5, II, p. 9; p. 11, I; p. 13; p. 16 top; p. 18; p. 22, II). This has been answered at pp. 16-17, supra.

Conflict of Second and Eighth Circuit decisions with decisions of this Court concerning continuation applications (Petition p. 5, II; pp. 8-9; p. 10; p. 11, I; p. 12, II; p. 18; p. 22, I; p. 22, II-p. 24). This has been answered at p. 19, supra.

Conflict between Second and Eighth Courts of Appeal and the Court of Customs and Patent Appeals on the legal status of the abandoned application: (Petition p. 2, par. 2; p. 6, III; p. 10; p. 11, I; p. 12, top; p. 12, II; p. 13; p. 15, IV; p. 22, I). That has been answered at p. 20, supra.

Conflict between Circuits on the question of validity (Petition p. 2, par. 3; p. 5, I; p. 11, I; p. 15, IV; p. 22, I). This has been answered at pp. 13-15, supra.

Conflict between each District Court and its Appellate Court on the question of validity: (Petition p. 5, I; p. 8; pp. 9-10, p. 11, I; p. 15, IV; p. 22, I). The Circuit Courts are courts of appeals; and the writ is asked to the Eighth Circuit Court of Appeals, where the patents have been held valid.

Conflict of Eighth Circuit decision with decisions of this Court, as to avoiding infringement by change from patent in suit: (Petition p. 7, IV; p. 10; p. 12, II; p. 14, III; p. 25, III; p. 26, Conclusion). This has been answered at pp. 17-18, supra.

Conflict of the decision of the Second Circuit with decision of this Court, as to prevision in chemistry: (Petition p. 16, V; p. 25, IV). That involves a decision of an Appellate Court to which no writ is asked; no such conflict is urged as to the Eighth Circuit, pp. 20-21.

The petition should be denied:

(1) No conflict exists of the decision of the Eighth Circuit with that of the Second Circuit, or with decisions of this Court, as to infringement.

(2) No review of the Eighth Circuit decision on validity can effect the result.

(3) No grave public interest, as distinguished from the private interest of petitioner, is present.

Respectfully submitted,

JOHN H. BRUNINGA,
Counsel for Respondents.

St. Louis, Missouri,
August 29, 1952.

Service of and copies acknowledged, August 29, 1952.

.....
Marion S. Francis,
Of Counsel for Petitioner.

Supreme Court, U.S.
FILED
SEP 13 1952
CHARLES ELMORE CROPLEY
CLERK

In the Supreme Court of the United States

OCTOBER TERM, A. D. 1952.

No. 239.

AERATION PROCESSES, INC.,
a corporation,
Petitioner,

vs.

LOUIS A. LANGE and JOSEPH B. WINKLER, etc., *et al.*,
Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

PETITIONER'S REPLY TO RESPONDENTS' ANSWER TO PETITION FOR WRIT OF CERTIORARI.

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A typical example is the *partial* quotation of the respondents from sentences of witnesses on the subject of the mixture of carbon dioxide (15%) and nitrous oxide (85%) being acid. The finding of the District Court, not reversed by the Court of Appeals of the Eighth Circuit, was exactly to the contrary. This Court cannot be expected to change the findings on fragmentary quotations from a record that has been closed.

In the foregoing statement you will find the answer to nine-tenths of respondents' brief.

WHY NO PETITION FOR CERTIORARI FROM THE SECOND CIRCUIT WAS FILED.

Reason I. There was no conflict between circuits.

Reason II. Litigation was pending in the Eighth Circuit, ready for trial, so that the issue could be brought up if the Eighth Circuit agreed with us and this Court would have the benefit of the opinions of both Circuits. This, of course, is the customary practice.

The Second Circuit decision was on Nov. 1, 1948, in New York and we went to trial in Missouri on Nov. 3, 1948.

Reason III. When any case is ordered up on certiorari in a patent suit, where the latest decision of a Court of Appeals is contrary to an earlier decision of another Circuit Court of Appeals, the party in the first proceeding is not normally before the Court. That has never been a reason for denying certiorari when the conflict did arise. **To hold otherwise would prevent this Court from rectifying errors in the public interest.**

This Court has announced frequently the deep public interest in patents, whether patents are defeated or sustained, because this Court is the guardian of our patent system and desires to see, in case of conflict, that even-handed

justice is done to the public as well as to the parties. It is our understanding that this is the philosophy underlying certiorari procedure.

We have never heard of the fact before, as stated by respondents, that the powers of this Court to order up any case on certiorari are limited by any reason whatsoever. It is purely discretionary in this Court.

MIXTURE OF GASES (N_2O AND CO_2) WAS NOT LEFT OUT OF THE ISSUED PATENTS AS CLAIMED BY RESPONDENTS.

(Respondents' Brief Pages 19-20.)

In patent No. 2,294,172 it specifically reserves the monopoly over nitrous oxide for which other gases may be partially substituted, saying:

> "Parallel results in many respects were obtained * * * **when carbon dioxide were substituted for nitrous oxide.**
>
> "Carbon dioxide, which reacts with water *to form free carbonic acid,* was open to the objection it gives a sharp and, to many people, an unpleasant taste to cream. * * * Nitrous oxide which is non-acid forming and **which is an inert gas under the conditions of use also yields satisfactory aerated products in which the cream content is homogenized cream,** * * *." (p. 2, lines 8 to 24.)

Anyone reading that statement would see that nitrous oxide was the preferred gas and was non-acid forming, but that carbon dioxide, although acid forming, might be used provided the amount was not sufficient to give "an unpleasant taste to cream."

With this teaching before the public that nitrous oxide was the preferred gas, but that carbon dioxide would not be injurious so long as it was not used in sufficient amount

to give an unpleasant taste, it would never occur to anyone, in view of the foregoing statement on the right-hand column of page 2 of patent No. 2,294,172, to hold that there was an intent to abandon a gas mixture.

That is exactly what the respondents did. The teaching of the possibility of making this mixture is taught in the Getz patent No. 2,294,172.

We do not believe any Court would claim there was invention by some later comer in putting a few per cent, such as 15% carbon dioxide into 85% nitrous oxide, when the District Court in this case in Missouri made a finding of fact that this 15% addition of CO_2 did not make the cream taste acid.

If it would need any further confirmation, other gases besides carbon dioxide are mentioned in the right-hand column on page 2; and claim 7 actually claims these other gases.

The position of respondents that this possible contamination was not contemplated by the patent in suit No. 2,294,172 and that there was intent to otherwise dedicate the combination, not only has no foundation in law, but is rebutted by the face of the patent.

As to the second patent No. 2,435,682, Dr. Getz specifically reserves this right, saying:

> "While nitrous oxide alone may be used as the aerating gas, under some circumstances, it may be advantageous to use mixtures of gases.
>
> * * * * *
>
> "* * * In general, a mixture of two or more of the gases hereinbefore referred to tends to increase the overrun, firmness, and freedom from drainage of the product. The advantages of such mixtures are, however, somewhat theoretical from a production standpoint, since nitrous oxide alone is satisfactory.

"The nitrous oxide need not be used in a pure form but may contain other gases so long as they do not interfere with the essential action of the nitrous oxide. For example, a minor amount of carbon dioxide mixed with nitrous oxide can be tolerated so long as the amount is not sufficient to cause an objectionable acid or biting taste to the product. Its use, however, is not recommended in an edible aerated cream." (Col 4, lines 27 etc.)

The foregoing statements do not sound like abandonment and dedication and failure of Dr. Getz to protect himself against infringers like respondents who would contaminate or cheapen in order to avoid their consequences of infringement.

Miscellaneous Errors. There seem to be several dozen partial quotations with deductions made which are not justified by the full quotations and misstatements of law and fact, but they are obvious. This Court will doubtless dispose of them in the usual manner as not essential at this moment. We do not so regard them and, therefore, find no reason to burden the Court with a discussion of them.

Respectfully submitted,

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